REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 9-16, 23, 25-33, 35-40, 42-44, and 47-9 are pending in this application. Claims 23, 25, 33, 39, and 40 are amended, Claim 17 is canceled without prejudice or disclaimer, and new Claims 48 and 49 are added by the present amendment. As amended Claims 23, 25, 33, 39, and 40 and new Claims 48 and 49 are supported by the original claims, no new matter is added.

In the outstanding Official Action, Claims 17, 23, and 25-31 were rejected under 35 U.S.C. §101; Claims 23, 25-33, 35-40, 42-44, and 47 were rejected under 35 U.S.C. §102(e) as anticipated by <u>Limon, Jr. et al.</u> (U.S. Patent No. 6,453,435, herein "<u>Limon</u>"); Claims 9-16 were rejected under 35 U.S.C. §103(a) as unpatentable over <u>Limon</u>; and Claim 17 was rejected under 35 U.S.C. §103(a) as unpatentable over <u>Limon</u> in view of <u>Miyata et al.</u> (Japanese Patent Application Publication No. 2000-047908, herein "<u>Miyata</u>").

With respect to the rejection of Claims 17, 23, and 25-31 under 35 U.S.C. §101, it is respectfully noted that Claims 17, 23, and 25-31 are directed to an information processing apparatus, and Claims 23 and 25-31 recite means-plus-function terminology.

Proper claim interpretation of a means-plus-function (35 U.S.C. § 112, 6th paragraph) element entails consideration of the structures disclosed in the specification and equivalents thereof.

In determining the scope of the claims prior to determining compliance with each statutory requirement for patentability, MPEP §2106 provides:

> Office personnel are to correlate each claim limitation to all portions of the disclosure that describes the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using <u>means or step plus function language</u>. The correlation step will ensure that office personnel will correctly interpret each claim limitation. (emphasis added).

Thus, Applicant respectfully submits that the rejection under 35 U.S.C. §101 of at least Claims 17, 23 and 25-31 are improper as these claims clearly recite apparatus claim limitations.

MPEP § 2106 further provides that:

> Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitations to a practical application in a technological arts should it be rejected under 35 U.S.C. § 101 . . . Further, when such a rejection is made, <u>office personnel must expressly state how the language of the claims has been interpreted to support the rejection</u>. (emphasis added) See MPEP § 2106.

The outstanding rejection states "the recited components e.g., a data sampling section ... a sample data file generation section ... a sample data presetting section ... of the claims can reasonably be interpreted as computer program modules/software per se as disclosed in the specification (paragraph [0030] and [195-198] of the publication)."[1] In fact, it is respectfully submitted such an interpretation is unreasonable. Paragraph 198 describes the hardware connections of sample data file generation section 24 to display section 2. No explanation has been provided as to how the clear description of apparatus components can be considered "software per se." Moreover, the specification clearly describes structure corresponding to the claim elements of Claims 23 and 25-31, such as debug function section 9 shown in Figure 43. Again, no explanation has been provided as to how, for example, the clear description of debug function section 9 shown in Figure 43 as part of a computer hardware system does not qualify as the means plus function elements recited in Claims 23 and 25-31.

Accordingly, should such a rejection be maintained in a subsequent communication with respect to any of the aforementioned claims, it is respectfully requested that the Examiner provide an express statement on the record in accordance with MPEP §2106

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[1]See the outstanding Office Action at page 3, lines 17-18 and page 5, lines 6-7.

guidelines explaining how such claim terminology, such as "a data sampling section,"

"means for reading," and "means for displaying" is interpreted. More specifically, how such

limitations are deficient to define a useful, concrete and tangible result. See State Street Bank

& Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1374, 47 (Fed. Cir. 1998)

(discussing practical application of a mathematical algorithm, formula, or calculation.).

Thus, Claims 17 and 23 recite apparatuses, which is one of the statutory types recited

in 35 U.S.C. §101. Accordingly, Claims 17, 23, and 25-31 are believed to be in compliance

with all requirements under 35 U.S.C. §101.

With regard to the rejection of Claims 23, 25-33, 35-40, 42-44, and 47 under 35

U.S.C. §102(e) as anticipated by Limon, that rejection is respectful traversed.

Claim 23 recites in part:

> a software recomposing section configured to
> recompose a software of inspection use in accordance with a
> type of the object; and
> means for reading inspection progress information
> related to the object during simulation, said means for reading
> displays a resultant on a screen of a display unit.

The outstanding Office Action cited column 2, lines 54-59 of Limon as describing "a

software recombining section" as defined in Claim 23.[2] However, well settled case low holds

that for a proper anticipation rejection "The identical invention must be shown *in as complete*

detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236,

9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added.) See also MPEP §2131. In the

present case, it is respectfully submitted that the description of "a test station" in Limon

which simply tests a unit does not teach "a software recombining section configured to

recombine a software of inspection use in accordance with a type of the object," as recited in

Claim 23. In fact, the cited portion of Limon does not in any way describe recombining

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[2]See the outstanding Office Action at page 13, lines 22 and 23.

software. Consequently, as <u>Limon</u> does not teach each and every element of Claim 23, Claim 23 is not anticipated by <u>Limon</u> and is patentable thereover.

As Claims 32 and 33 recite similar features to those of Claim 23 in method form, it is respectfully submitted that Claims 32 and 33 are patentable for at least the reasons described above with respect to Claim 23.

Claim 42 recites a general purpose inspecting system comprising, *inter alia*:

> a controlled device configured to perform a prescribed function;
> an interface section configured to indicate a status of the controlled device;
> a control processor configured to inspect the controlled device by transmitting a prescribed command to the controlled device; and
> means for determining *in advance* to transmission of the prescribed command whether an execution result of command processing will be abnormal by accessing the interface section and acquiring information of *status of the controlled device*.

The outstanding Office Action asserted that the control portion described at column 3, lines 48-50 of <u>Limon</u> is "a controlled device," the upper portion described as column 3, lines 26-28 in a different embodiment of <u>Limon</u> is "an interface section," column 18, lines 30-34 of <u>Limon</u>, which does not identify any particular part, as describing "a control processor," and optical power meter instrument 86 of <u>Limon</u> as "means for determining."[3] However, optical power meter instrument 86 of <u>Limon</u> is used to evaluate optical output of UUT 13 *after* macro commands are issued, as described at column 14, lines 38-51 of <u>Limon</u>. It is respectful is submitted that no portion of <u>Limon</u> teaches or suggests that optical power meter instrument 86 determines *in advance* to transmission of a prescribed command whether an execution result of command processing will be abnormal. In this regard, the sections of columns 5-7 of <u>Limon</u> cited for this feature are in fact irrelevant to this feature. Accordingly, it is respectfully submitted that <u>Limon</u> does not teach or suggest "means for determining" as

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[3]See the outstanding Office Action at page 185, lines 2-22.

recited in Claim 42. Consequently, Claim 42 (and Claims 43 and 44 dependent therefrom) is not anticipated by Limon and is patentable thereover.

Claim 47 recites in part, "determining if a transient phenomenon occurs when a controlled device transmits acknowledge," "repeatedly transmitting the prescribed command until the transient phenomenon is terminated from said controlled device," and "awaiting user input after termination of the transient phenomenon."

The outstanding Office Action cited communication between the UUT and test station 23 of Limon as "a transient phenomenon."[4] However, if communication between the UUT and test station 23 of Limon is considered "a transient phenomenon," then to practice the feature "repeatedly transmitting the prescribed command until the transient phenomenon is terminated from said controlled device" would require the UUT and test station 23 of Limon to repeatedly transmit a command until communication is terminated, which would result in perpetual communication of the command. As Limon clearly does not describe such a method, and very be no suggestion or motivation to practice such a method, Limon clearly does not teach or suggest "repeatedly transmitting the prescribed command until the transient phenomenon is terminated from said controlled device" as recited in Claim 47. Consequently, Claim 47 is not anticipated by Limon and is patentable thereover.

With regard to the rejection of Claims 9-11 under 35 U.S.C. §103(a) as unpatentable over Limon, that rejection is respectful traversed.

Claim 9 recites an inspecting apparatus comprising, *inter alia*:

> *a displaying device configured to display a list of the circuit baseboards;*
> *a determining device configured to determine a type of a circuit baseboard selected from the list via the displaying device;* and
> a PLD file specifying device configured to refer to the correspondence information of the registering memory and

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[4]See the outstanding Office Action at page 20, line 15 to page 21, line 8.

specify an applicable PLD file based upon the circuit
baseboard type; and
        a loading device configured to load the PLD with the
applicable PLD file.

The outstanding Office Action cited column 3, line 65-67 of <u>Limon</u> as describing "a

displaying device" and column 6, lines 39-43 of <u>Limon</u> as describing "a determining device

configured to determine a type of a circuit baseboard selected from the list via the displaying

device."[5] However, it is respectfully submitted that no part of <u>Limon</u> describes a display

displaying a list of circuit baseboards, much less *selecting of a circuit baseboard from the*

displayed list. <u>Limon</u> simply describes that a barcode is provided on label 117 on each UUT.

Thus, there is no teaching of any kind in <u>Limon</u> of a selection from among displayed types

of circuit baseboards. As <u>Limon</u> does not teach or suggest "a displaying device" and "a

determining device" as recited in Claim 9, Claim 9 (and dependent Claims 12-16) is

patentable over <u>Limon</u>.

Claims 10 and 11 recite "an ID reading device" and "an ID determination device,"

respectively. The outstanding Office Action generally alleged that <u>Limon</u> describes these

elements under the same rationale set forth in the rejection of Claim 9.[6] However, <u>Limon</u>

simply describes that a barcode is provided on label 117 on each UUT. <u>Limon</u> does not

describe any element that reads labels 117. Therefore, <u>Limon</u> does *not* teach or suggest "an

ID reading device" and "an ID determination device" as defined in Claims 10 and 11. As a

prima facie case of obviousness requires that ***each and every element of the claim be taught***

or suggested by one of the cited references, it is respectfully submitted that *prima facie* case

of obviousness has not been made with respect to Claims 10 and 11 (and dependent Claims

12-16). Accordingly, it is respectfully requested that the present rejection be withdrawn. If

the outstanding rejection of Claims 10 and 11 are not withdrawn, it is respectfully requested

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[5]See the outstanding Office Action at page 6, lines 11-18.
[6]See the outstanding Office Action at page 7, lines 9-11.
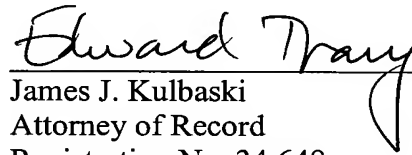
that for the purposes of appeal the next Office Communication provide the part number of the

device described by <u>Limon</u> that is alleged to be "an ID reading device" and "an ID

determination device" as defined in Claims 10 and 11.

With respect to the rejection of Claim 17 under 35 U.S.C. §103(a) as unpatentable

over <u>Limon</u> in view of <u>Miyata</u>, Claim 17 is canceled without prejudice or disclaimer

herewith, making this rejection moot.

Accordingly, in view of the present amendment, no further issues are believed to be

outstanding and the present application is believed to be in condition for formal allowance.

An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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